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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,999	09/12/2003	Scott Trees	BAL6019P0022US	6084
32116	7590	08/25/2004	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			MCCORMICK EWOLDT, SUSAN BETH	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/660,999	TREES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Susan B. McCormick-Ewoldt	1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 September 2003.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-86 is/are pending in the application.  
 4a) Of the above claim(s) 1-61 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 62-86 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Detailed Action**

**Status of Application**

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1654.

**Drawings**

Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

In addition, Applicant is reminded to submit three copies of the drawings.

**Claims**

Applicant has canceled claims 1- 61 in paper dated May 7, 2004 and new claims 62-86 have been added.

**Claim Rejections- 35 U.S.C. 102/103**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 65-67, 69, 74-77, 79, 82-84, 86 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cosner (U.S. Patent No. 6,353,162). Cosner discloses New Guinea impatiens plants having striped petals (referred to as "marbled"). See Figs. 2 and 3; col. 9, lines 2-4. Cuttings (col. 20, lines 34-37), pollen and ovules (col. 23, lines 17-25) are also disclosed. The claims do not recite any other characteristic that would distinguish the claimed plants from those of the prior art. Even if the claimed plants possess some characteristic not possessed by those of Cosner, the invention would still be obvious because Cosner teaches that mutagenesis is commonly used to produce sports (col. 2, l. 56-60).

The courts have approved the use of 102/103 rejection for product-by-process claims. See MPEP 2113.

#### Claim Rejections- 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 68, 78, 85 are rejected under 35 under U.S.C. 103(a) as being unpatentable over Cosner in view of Stephans *et al.* Cosner teaches New Guinea impatiens having striped flowers. Cosner does not teach cultures of regenerable cells from these plants. Stephans *et al.* teach using tissue culture in New Guinea impatiens as a means of asexual propagation (pg. 163). It would have been obvious to one of ordinary skill in the art at the time the invention was made to propagate the plants of Cosner using tissue culture as taught by Stephans et al., with the advantages being: maintaining a virus-free stock, breeding programs can quickly be increased, certain genotypes are difficult to propagate by conventional methods and using less space (Stephans et al., pg. 165). Thus the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 62-64, 70-73, 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosner in view of Datta, Broertjes *et al* and Sharova *et al.* Cosner teaches New Guinea impatiens having striped flowers by disclosing x-rays and chemical mutagens have been used to produce sports, but does not teach the methods for doing so (col. 2, line 56). Datta discloses the use of gamma rays for changing the flower color; in particular, some

cultivars show the petals having striped petals. (See examples on page 57, last paragraph; page 65, 3<sup>rd</sup> paragraph; page 68, 4th paragraph; page 69 last paragraph; page 170, last paragraph and page 174, various cultivars under "Rose".) Broertjes *et al.* disclose production of petals that are striped in many different plants (dahlia on pg. 84 'Altamira'- orange and red strips; alstroemaria on pg. 154 'Zebra Stazeb'- heavily striped flower; carnation on pg. 159, 'Sim Feu Follet'- large yellow flower with broad red flowers.). See Chapter 5. Sharova *et al.* disclose using chemical mutagens in addition to irradiation to cause "petal mottling" in balsam (see page 9, 3<sup>rd</sup> paragraph and Table 2). Balsam is in the *Balsaminaceae* family that also includes the New Guinea impatiens that has been developed from species of *Impatiens hawkeri*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use irradiation and/or chemical mutagenesis as taught by Datta, Broertjes *et al.* and Sharova *et al.*, with the motivation being to obtain an easily applicable, clean method with good penetration of reproducibility, high mutation frequency and large economic importance to the horticulture industry (Broertjes *et al.* page 12-13). There would have been a reasonable expectation of success, because it was already known that striped petals could be produced in impatiens. Thus the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

#### Conclusion

No claim is allowed.

#### Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campbell, can be reached on (571) 272-0974. The official fax number for the group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

  
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